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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,960	07/20/2005	Frank Kurfiss	10191-3363	6926
26646	7590	10/03/2005	EXAMINER RAEVIS, ROBERT R	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			ART UNIT 2856	PAPER NUMBER

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/506,960

Applicant(s)

KURFISS ET AL.

Examiner

Robert R. Raevis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 14-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9-7-04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Election of Group II is acknowledged.

Claims 10,14-16,18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 10, what is the structure contacting ("contact" on line 3)?

As to claim 13, what do the "medium" (line 2) and "the medium" (line 3) correspond to in the drawings/written-specification? Is it the material of construction (i.e. the "medium") of either device 30 or lens 12? Also, p. 2 (lines 6-7) suggest that there is a single material that defines the "medium" (p. 2, line 7), yet claim 13 refers to two (different) mediums ("medium" of line 2, "medium" of line 3). Is the same medium inadvertently being claim twice in this claim? Also, what does "optically" and "condensed" mean?

As to claim 15, what does the adjective "contact" (line 4) structurally add to the phrase "contact space"? Does it mean that the "device" is contacting something/some-space?

As to claim 18, what does the two different(?) mediums does "optically, ...medium" (lines 2-3) correspond to in the drawings/written-specification? Again, note that claim 18 calls for two different mediums. Also, this is a method claim that depends upon an apparatus claim. Is claim 18 a method or apparatus?

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Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claim 18, what particular materials provide for the two mediums (one "optically, condense" and the other "NIR-transparent, condensed") alternatives here?

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10,14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kalb.

Kalb teaches (Figure 1) a device, including: a structure (26,28) including a contact space 42; wherein the contact space 42 is sealed, and a partial vacuum is provided in the contact space. Only coincidentally, Kalb's contact space is between the sensor 34 and a part 22 which the sensor is to be connected to.

As to claim 10, note that the phrase "*for attaching...motor vehicle*" (italics added, lines 1-2) is expressly a statement of intended use for the claimed combination. In addition, note that the phrase "*to be located between...pane*" (italics added, lines 3-4) is

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also an express statement of intended use. Reference Kalb teaches the claimed structure.

As to claim 14, note the stops 46 that "provide a stop for compression of the cup against the part" (col. 2, lines 18-19). In addition, the stops face in the direction of the part 22 to be attached to the device. Finally, the "glass pane" (last line) is not part of the "connecting device", and is expressly a use of the device. Again, reference Kalb teaches the claimed structure.

Claims 10, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Teder et al '493.

As to claim 10, Teder et al teach a device to attach a sensor 24 to a glass pane of a vehicle, including: a structure 70 including a contact space to be located between the sensor and the portion of the pane outside of the seal, wherein a contact space is sealed to permit for removal of air from cavity ("air is removed from the cavity", col. 9, line 21), and a partial (note "total vacuum may not be achieved" on col. 9, lines 15-16) vacuum is provided in the contact space during such air removal.

As to claim 15, Teder et al teach a method of attaching a sensor device relative to a glass pane, comprising: situation a connecting device 70 between a sensor 24 and the glass pane in an area defining a contact space; and generating a partial (note "total vacuum may not be achieved" on col. 9, lines 15-16) "vacuum" (col. 9, line 16) in the contact space.

As to claim 18, note the "clear adhesive interlayer 30" (col. 7, line 1) that "optically couples the light pipes to the pane 52.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kroczyński et al teach positioning a sensor 9 within a sealed area within a suction cup, but is unrelated to "a glass pane of a motor vehicle" (line 1 of Applicant's claim 15).

Koyama et al teach bonding ("bonded" on col. 4, line 12) a sensor to a windshield, and Teder '183 teaches use of double-sided adhesive interlayer 34; but neither teaches use of "vacuum" (line 5 of Applicant's claim 15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert R. Raevis whose telephone number is 571-272-2204. The examiner can normally be reached on Monday to Friday from 5:30am to 3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams, can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Rogers*

RAEVIS